

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	§	Group Art Unit:	1794
Steven Tysoe et al.	§		
	§		
Application No.:	10/672,623	§	Confirmation No.: 8056
	§		
Filed:	September 26, 2003	§	Examiner: Le, Hoa T.
	§		
For:	SOFT MAGNETIC PARTICLES METHODS OF MAKING AND ARTICLES FORMED THEREFROM	§	Atty. Docket: 134763-1/YOD/SIN GERD:0381
	§		
	§		

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July 8, 2009

Date

/Patrick S. Yoder/

Patrick S. Yoder

**RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL  
BRIEF**

This Response is being filed in reply to the Notice of Non-Compliant Appeal Brief mailed on April 8, 2009.

The Appellants hereby request a two (2) month extension in the statutory period for response to the Notification of Non-Compliant Appeal Brief from May 8, 2009 to July 8, 2009 in accordance with 37 C.F.R. § 1.136. The Commissioner is authorized to charge the requisite fee of \$490.00, and any additional fees which may be required, to the credit card charge authorization submitted electronically with the present filing. However, if for any reason this charge fails, the Commissioner is authorized to charge Deposit Account No. 06-1315; Order No. GERD:0381/YOD (134763-1).

**REMARKS**

In the Notification of Non-Compliant Appeal Brief Form PTOL-462 mailed April 8, 2009, the Examiner checked Box 4, which states:

(a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).

*See* Notification of Non-Compliant Appeal Brief Form PTOL-462 mailed April 8, 2009.

In addition, in the "Other (including any explanation in support of the above items)" section of the Notification of Non-Compliant Appeal Brief Form PTOL-462, the Examiner stated:

*The Summary of Claimed Subject Matter contained in the brief is deficient. 37CFR41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal. The brief is deficient because the first four paragraphs of the Summary section are not material to the claimed subject matter i.e. magnetic particles. The claimed invention is directed to soft magnetic particles only, not to electromagnetic devices or methods of making such devices or methods of making magnetic particles as discussed in the first four paragraphs of the Summary.*

*See id* (emphasis in original).

Therefore, it appears that the Examiner considers the Summary of Claimed Subject Matter section of the Appeal Brief to be deficient because it contains *additional*

explanation of the specification of the present application *in addition to* a concise explanation of the subject matter defined in each of independent claims 1, 25, and 31 of the present application. However, the Appellants contend that the Appeal Brief, as filed, is in compliance with 37 C.F.R. § 41.37 and, in particular, 37 C.F.R. § 41.37(c)(1)(v), which states:

*Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

*See* 37 C.F.R. § 41.37(c)(1)(v).

The Appellants note that 37 C.F.R. § 41.37(c)(1)(v), as well as Box 4 of the Notification of Non-Compliant Appeal Brief Form PTOL-462, which was checked by the Examiner, merely require that the Appellants (1) provide a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters, and (2) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and (3) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters. *See id.*; Notification of Non-Compliant Appeal Brief Form PTOL-462 mailed April 8, 2009.

The Appellants contend that all three of these requirements are met by the Appeal Brief, as filed. For example, page 3, line 15 through page 4, line 22 of the Appeal Brief provides a concise explanation of the subject matter defined in independent claims 1, 25, and 31 of the present application, referring to the specification by page, paragraph, line number, and drawings. *See Appeal Brief, page 3, line 15 – page 4, line 22.* As such, page 3, line 15 through page 4, line 22 of the Appeal Brief also sets forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page, paragraph, line number, and drawings. *See id.* However, none of independent claims 1, 25, or 31 contain means plus function language. Therefore, that particular requirement is not pertinent.

As such, the Appellants strongly contend that the Appeal Brief, as filed, is in compliance with 37 C.F.R. § 41.37(c)(1)(v). Indeed, it appears that the only objection to the Summary of Claimed Subject Matter raised by the Examiner is the fact that *additional* explanation of the subject matter of the present application is provided as context for the claimed subject matter. However, the Appellants respectfully note that 37 C.F.R. § 41.37(c)(1)(v) does not preclude the inclusion of additional explanation of subject matter of the specification of the present application. The fact that the Appeal Brief discusses subject matter from the specification of the present application which is slightly broader than the claimed subject matter (e.g., electromagnetic devices vs. soft magnetic particles), as suggested by the Examiner, is irrelevant.

**Conclusion**

For these reasons, the Appellants respectfully submit that the present Notification of Non-Compliant Appeal Brief is improper and that the Appeal Brief, as filed, is in compliance with 37 C.F.R. § 41.37 and, in particular, 37 C.F.R. § 41.37(c)(1)(v). If the Examiner believes that any outstanding issues still remain, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: July 8, 2009

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